of documents that is organized into a hierarchy of electronic folders. More importantly, however, the method includes the steps of storing the imported document into memory and extracting therefrom attribute data (e.g., title, author, document type, document size, document content). The attribute data extracted from the imported document is contained in a data structure that is separate from the imported document itself. Ultimately, the imported document is linked to an electronic folder, in the hierarchy of electronic folders, if the attribute data extracted from the imported document and contained in the separate data structure matches a set of predefined criteria corresponding to the at least one electronic folder.

First, the present invention, as defined by claim 1, involves managing a collection of electronic documents. The present invention does not manage, alter, or otherwise affect the contents of the electronic documents, nor does the present invention involve publishing the contents of the electronic documents. Zarmer, in contrast, specifically involves a "**publishing tool** that allows information providers to **manage the content** they provide to online services" (emphasis added). Accordingly, Zarmer and the present application have little in common.

Second, Zarmer fails to teach or suggest several of the method steps associated with claim 1. Of particular significance is the fact that Zarmer fails to teach or suggest the step of "linking the imported document to a first electronic folder if the attribute data contained in said data structure matches a set of predefined criteria corresponding to the first electronic folder." The Office Action states that Zarmer, at column 6, lines 12-15 and lines 35-40, teaches "linking an imported document to a first electronic folder", but not "if the attribute data contained in the data structure matches a set of predefined criteria corresponding to the first electronic folder." The Action states goes on to state, however, that it would have been obvious "to have a set of predefined criteria because the information in the data structure is arranged in a certain way in the computer memory with the attributes in the data structure being those of files marked as hidden, read-only, and archive."

The rejection of claim 1 under 35 U.S.C. §103, and in particular, the assertion that the step of "linking the imported document to a first electronic folder if the attribute data contained in said data structure matches a set of predefined criteria corresponding to the first electronic folder" would have been obvious to one of ordinary skill in the art is improper.

As the Examiner is well aware, each claim must be interpreted as a whole. It is inappropriate to dissect the claim into individual parts, and then interpret these parts in isolation. The requirement that the Examiner interpret each claim as a whole comes directly from the statue, the relevant parts of which are reproduced herein below:

> 35 U.S.C. 103 Conditions for Patentability; Non-Obvious Subject Matter
>
> (a) A patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter **as a whole** (*emphasis added*) would have been obvious at the time the invention was made...."

In the Office Action, the last step of claim 1 is dissected into two independent parts: a first part which involves the first half of the step "linking the imported document to a first electronic folder," and a second part which involves the last half of the step, "if the attribute data contained in said data structure matches a set of predefined criteria corresponding to the first electronic folder." The Office Action states goes on to state that Zarmer teaches the first part (i.e., "linking the imported document to a first electronic folder"), but not the second part (i.e., "if the attribute data contained in said data structure matches a set of predefined criteria corresponding to the first electronic folder"). The Office Action then states that the second part, independent of the first part, would have been obvious to one of ordinary skill. However, the Applicants respectfully contend that it is immaterial to the patentability of claim 1 whether the second part, independent of the first part, would have been obvious to one of ordinary skill. It is only material whether the

entire step in context with the claim as a whole would have been obvious to one of ordinary skill in the art. By dissecting the last method step into two independent parts, and interpreting them in isolation, the last step of claim 1 has been interpreted in a way that is contrary to the true meaning and purpose of the step. Of course, this is the very reason why the statute requires the Examiner to interpret each claim as a whole. Because claim 1 was not examined and interpreted as a whole, as required under 35 U.S.C. §103, the Applicants respectfully contend that the refection of claim 1 is improper.

In addition, the Applicants respectfully contend that the Office Action fails to establish a prima facie case of obviousness. It is well understood that in order to establish a prima facie case of obviousness, three basic criteria must be met. One of these criteria is that there must be some motivation to modify the reference (i.e., Zarmer) to include the claim feature not taught or suggested by the reference. Moreover, the motivation statement should come from the reference itself. As stated above, the Office Action admits that Zarmer does not teach or suggest the second half of the last step in claim 1, which reads, "if the attribute data contained in the data structure matches a set of predefined criteria corresponding to the first electronic folder." The Office Action further states that it would have been obvious "to have a set of predefined criteria because the information in the data structure is arranged in a certain way in the computer memory with the attributes in the data structure being those of files marked as hidden, read-only, and archive." First, it is unclear to the Applicants how a data structure containing attributes arranged in a certain way serves as motivation to one of ordinary skill to modify Zarmer in accordance with the last method step of claim 1. Attribute data in a data structure may be specifically arranged for any number of reasons. For instance, the attribute data may be arranged in an order that is based on priority, or arranged so that the attribute data is presented in a manner that is consistent with other data structures, or arranged so that it is easier to read the attribute data. The fact that attribute data is arranged in a data structure in a certain way, in and of itself, simply does not serve as motivation to modify Zarmer in accordance with the last step of claim 1. Second, it is unclear where Zarmer teaches a data structure containing

such an arrangement of attributes. Consequently, the Applicants contend that the Office Action fails to set forth a prima facie case of obviousness, and that the rejection of claim 1 is improper.

For at least those reasons presented above, claim 1 is patentable over Zarmer. Moreover, independent claim 51 is substantially similar to independent claim 1, but for claim 51 expressly defines the present invention in terms of a computer program rather than a general method for managing a document collection in a computer system. For this reason, claim 51 is also patentable over Zarmer. Claims 2-28, 30-50 and 53-83 are also patentable as they variously depend from either claim 1 or claim 51. Accordingly, the Applicants respectfully request that the various claim rejections be withdrawn.

The application is in condition for allowance. Notice of same is earnestly solicited. If the Examiner has any questions regarding this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

Respectfully submitted,

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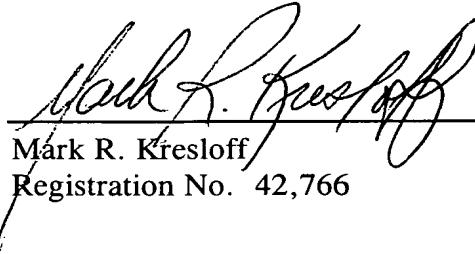
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